

REMARKS

Claims 1-10 remain pending in this patent application.

*Rejection under 35 USC § 112, First Paragraph*

In the last Office Action, the Examiner rejected claims 1-10 under 35 USC § 112, first paragraph. Applicant respectfully traverses this rejection.

In this application as filed, claim 1 recited "a percentage of the number of dimples having a contour length of greater than or equal to 11.6 mm based on the total number of dimples formed over the surface thereof of greater than or equal to 50%" (hereafter, "percentage range"). The Amendment filed on February 3, 2003, included new claims 11 and 12, dependent from claim 1, that recited the percentage range as greater than or equal to 55% and 60%, respectively. In the Amendment filed on July 13, 2004, claim 11 was canceled, and claim 1 was amended to recite the percentage range as greater than or equal to 55%. In the Amendment filed on January 19, 2005 (entered on February 22, 2005 with the filing of an RCE), claim 12 was canceled, and claim 1 was amended to recite the percentage range as greater than or equal to 77%.

In addition to the original claims, the original disclosure in this application provides disclosures supporting the claimed range at the following places:

Percentage range  $\geq$  50%

- Abstract, last two lines
- Specification, page 2, lines 28-30
- Specification, page 12, lines 19-23

Percentage range  $\geq$  55%

- Specification, page 12, lines 23-24

Percentage range  $\geq$  60%

- Specification, page 12, lines 24-25

Percentage range  $\geq$  77%

- Table 5, Examples 1, 5-8, 10

In the five Office Actions issued by the Examiner before the Advisory Action dated February 10, 2005, the Examiner had not made an issue of the percentage range recited in the claims. As detailed above, the percentage range recited in claims considered by the Examiner in those Office Actions had changed as the claims were amended. In the Advisory Action dated February 10, 2005, the Examiner denied entry of the January 19, 2005 Amendment on the ground that it raised the issue of new matters, adding (on the continuation sheet), "original specification does not support the range greater than 77% in claim 1." In the last Office Action, the Examiner states, "Claim now recites the number of dimples with a contour length greater than or equal to 11.6 is 77% or more. The specification supports 77% and 93% but nothing between or higher."

In earlier Office Actions, the Examiner was apparently not troubled by the recitation in the claims of percentage ranges of  $\geq$  50% or  $\geq$  55% or  $\geq$  60%. Why, then, does the Examiner take issue with the claimed percentage range of  $\geq$  77%? The Examiner seems to be saying, that, since the original disclosure does not disclose data for specific examples between 77% and 93%, and does not disclose data for specific examples higher than 93%, the claimed percentage range of greater than or equal to 77% is not supported by the original disclosure. (The Examiner's statement appears to ignore Example 10 in Table 5, in which the

percentage range is 100%.) Taken to its logical conclusion, the Examiner's position would effectively prevent applicants from claiming any percentage range without presenting data for specific examples at each increment in the range. Clearly, such a conclusion would violate any reasonable interpretation of the requirements of 35 USC § 112, first paragraph.

The Examiner's statement of the § 112, first paragraph is clearly at odds with the policy of the U.S. Patent and Trademark Office, as stated in the Manual of Patent Examining Procedure (Rev. 2, May 2004, hereafter "MPEP"). According to the guidelines stated in MPEP 2163:

The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. *Wertheim*, 541 F.2d at 263, 191 USPQ at 97. In rejecting a claim, the examiner must set forth express findings of fact regarding the above analysis which support the lack of written description conclusion.

AND

If applicant amends the claims and points out where and/or how the originally filed disclosure supports the amendment(s), and the examiner finds that the disclosure does not reasonably convey that the inventor had possession of the subject matter of the amendment at the time of the filing of the application, the examiner has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims.

In stating the rejection under 35 USC § 112, first paragraph, the Examiner has simply stated a conclusion without citing evidence or setting forth the findings of fact required by the passages in the MPEP reproduced above.

The discussion, in MPEP 2163.06, of *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976), is relevant to the § 112, first paragraph issue raised by the Examiner. In that case, "the ranges described in the original specification included a range of "25%-60%" and specific examples of "36%" and "50%." A corresponding new claim limitation to "at least 35%" did not meet the description requirement because the phrase "at least" had no upper limit and caused the claim to read literally on embodiments outside the "25% to 60%" range, *however a limitation to "between 35% and 60%" did meet the description requirement.*" (Emphasis added.)

The claimed percentage range of  $\geq 77\%$  is clearly within and supported by the disclosures of the percentage range in the application as filed. In view of the foregoing observations and arguments, Applicant respectfully submits that the Examiner's rejection of claims 1-10 under 35 USC § 112, first paragraph, is in error and should be withdrawn.

*Rejection under 35 USC § 103(a)*

The Examiner also rejected claims 1-10 under 35 USC § 103(a) as being unpatentable over JP 10-248958 (Satoshi '958) in view of US 5776013 (Yokota et al.). Applicant respectfully traverses this rejection.

Without acquiescing in the rejection, Applicant has amended claim 1 to call for a "surface area occupation ratio in the range of 78.5% to 88%. Support for this amendment resides in the original specification in lines 13-28. See also the examples in Table 5.

The present invention is directed to a golf ball having as a significant feature a minimum percentage of dimples with a

contour length of 11.6 mm or more, wherein this minimum percentage is 77% as recited in claim 1. The golf balls of the present invention exhibit improved flight performance and shot feel properties as shown in Tables 7 and 8 on pages 24-25 of the specification. Note, for example, that Example 5 (77% dimples with appropriate contour length) exhibits advantageously improved flight distance (or "carry") properties over Example 11 (50%) and Example 2 (63%). The present invention is also directed to a golf ball in which the dimples have a surface area occupation ratio of 78.50% to 88%, as now recited in claim 1. As discussed on page 13 of the specification and shown in Tables 7 and 8, balls incorporating this feature exhibit superior flight performance.

Satoshi '958 is mentioned at page 1 of the present specification. Satoshi '958 includes a "computer translation" into English which describes various materials for the core and cover of various golf balls. Satoshi '958 discloses in [0016]-[0017] a core which exhibits a compression in the range of 2.5-4.5 mm by applying an initial load of 10 kg up to 130 kg. The computer translation of Satoshi '958 does not include specific information regarding the dimple diameter or contour lengths of the dimples. It appears that all the examples of Satoshi '958 are golf balls having a diameter of 42.7 mm.

As acknowledged by the Examiner, Satoshi '958 does not disclose or suggest the golf ball of the present invention which includes at least 77% of the dimples with an appropriate contour length. Thus, Satoshi '958 fails to recognize the advantages achieved by the present invention which employs appropriate contour length dimples in an amount of at least 77% in order to achieve unexpectedly advantageously improved flight distance

properties as discussed above. In addition, Satoshi '958 does not disclose or suggest the golf ball of the present invention in which the surface area occupation ratio of the dimples is in the range of 78.50% to 88%. Accordingly, significant patentable distinctions exist between the present invention and Satoshi '958. In addition, even if it were assumed hypothetically that Satoshi '958 presents evidence of prima facie obviousness, such evidence has been rebutted by the comparative tests results disclosed in the present specification and discussed above.

Yokota et al. is a newly cited reference. As characterized by the Examiner, Table 4 in Yokota et al. discloses, as "Kind B" a golf ball wherein 83% of the dimples have a contour length greater than 11.6 mm. (Regarding Table 4 in Yokota et al., Applicant would like to point out that there is an obvious error in the number of dimples having a diameter of 3.8 mm in Kind B. The number of these dimples is 210, not 114, and the total number of dimples is 410, not 314 as erroneously stated in the table.) With regard to the subject matter recited in claims 9 and 10, the Examiner states that Yokota et al. teach from 330 to 440 dimples, adding that Kind B in Table 4 has 360 dimples. Notwithstanding the disclosures in Yokota et al. identified by the Examiner, Applicant finds no disclosure in Yokota that can meet the requirement in claim 1, as now amended, for a golf ball having a percentage of longer contour length dimples in the range of greater than or equal to 77% along with a surface area occupation ratio Y in the range of 78.50% to 88%. As pointed out above this claimed feature contributes to favorable flight performance of the golf ball. In golf balls with dimples having a longer contour length, the space between the dimples is correspondingly large. By virtue of the present invention, a

dimple pattern incorporating both a high occupation ratio and dimples with a longer contour length has been realized.

Clearly, there is no disclosure in Yokota et al. that can remedy the deficiencies in Satsohi '958 vis-à-vis the requirements of claim 1 as now amended. Accordingly, the disclosures in Satoshi '958 and Yokota et al. cannot properly serve as a basis for rejecting Applicant's claims under 35 USC § 103(a).

*Conclusion*

It is submitted for the reasons stated above that the present claims define patentable subject matter such that this application should now be placed condition for allowance.

If unresolved issues remain in this application, the Examiner is invited to contact Frederick R. Handren, Reg. No. 32,874, at the phone number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees. This authorization applies in particular to extension of time fees.

Respectfully submitted,

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3673-0128P